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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,852	11/20/2003	Natasha P. Hixon	2916-4842. 1US	1905

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EXAMINER

CHOI, STEPHEN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/718,852	Applicant(s) HIXON ET AL.	
	Examiner Stephen Choi	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-77 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1. Claims 1, 9-10, 12, 18, 24-25, 29, 35-36, and 54 are, drawn to a die comprising a planar plate and cutting edge protruding from the plate about 0.015 inch to about 0.02 inch, classified in class 83, subclass 531.

Group 2. Claims 2-5, 19-22, and 37-39 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch, and an ejection element, classified in class 83, subclass 123.

Group 3. Claims 49-51 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate, and an ejection element, classified in class 30, subclass 229.

Group 4. Claims 6-7, 27, and 40 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch, and the planar plate and the cutting edge comprising the same material wherein a thickness of the plate is less than the height of the cutting edge, classified in class 83, subclass 698.11.

Group 5. Claim 52 is, drawn to a die comprising a planar plate, cutting edge protruding from the plate, and the planar plate wherein a thickness of the plate is less than the height of the cutting edge, classified in class 30, subclass 231.

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Group 6. Claims 8, 23, and 47 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch wherein the plate comprising one of a magnetic material and a magnetically attractable material, classified in class 83, subclass 698.21.

Group 7. Claim 60 is, drawn to a die comprising a planar plate, cutting edge protruding from the plate wherein the plate comprising one of a magnetic material and a magnetically attractable material, classified in class 30, subclass 296.1.

Group 8. Claims 11, 28, and 41 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch wherein the plate has a thickness of about 0.01inch, classified in class 83, subclass 533.

Group 9. Claim 53 is, drawn to a die comprising a planar plate, cutting edge protruding from the plate wherein the plate has a thickness of about 0.01inch, classified in class 30, subclass 194.

Group 10. Claims 13-16, 30-33, and 42-45 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch wherein at least one peripheral dimension of the plate is at most about 2 inches or rectangular in shape at most about 2 inches by about 2 inches, classified in class 83, subclass 541.

Group 11. Claims 55-58 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate wherein at least one peripheral dimension

of the plate is at most about 2 inches or rectangular in shape at most about 2 inches by about 2 inches, classified in class 30, subclass 231.

Group 12. Claims 17, 34, and 36 are, drawn to a die comprising a planar plate, cutting edge protruding from the plate about 0.015 inch to about 0.02 inch wherein the plate has dimensions which facilitate compact and portable storage with a plurality of other similarly dimensioned dies, classified in class 83, subclass 701.

Group 13. Claim 59 is, drawn to a die comprising a planar plate, cutting edge protruding from the plate wherein the plate has dimensions which facilitate compact and portable storage with a plurality of other similarly dimensioned dies, classified in class 30, subclass 1.

Group 14. Claims 61-77 are, drawn to a die comprising a planar plate including a back side configured to be supported by a portable press and having a thickness maintain its planarity when not supported and a cutting edge protruding from the plate wherein pressure is applied to a back side of the plate, classified in class 100, subclass 227.

Claim 48 will be examined if any of groups 1, 3, 5, 7, 9, 11, and 13 is elected.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of groups 1-13 are related as combination and subcombination.

Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05 (c), example 3. For example, group 3 is evidence that the combination of group 2 does not rely on the

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cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 2 does not rely on the ejection element of group 3 for patentability. Group 5 is evidence that the combination of group 4 does not rely on the cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 4 does not rely on the cutting edge protruding from the plate a distance greater than the thickness of the plate of group 5 for patentability. Group 7 is evidence that the combination of group 6 does not rely on the cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 6 does not rely on the plate comprising one of a magnetic material and a magnetically attractable material of group 7 for patentability. Group 9 is evidence that the combination of group 8 does not rely on the cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 8 does not rely on the plate having a thickness of about 0.01 inch of group 9 for patentability. Group 11 is evidence that the combination of group 10 does not rely on the cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 10 does not rely on the at least one peripheral dimension of the plate being at most about 2 inches or rectangular in shape at most about 2 inches by about 2 inches of group 11 for patentability. Group 13 is evidence that the combination of group 12 does not rely on the cutting edge protruding from the

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plate about 0.015 inch to about 0.02 inch of group I for patentability, and conversely, group I is evidence that the combination of group 12 does not rely on the plate having dimensions which facilitate compact and portable storage with a plurality of other similarly dimensioned dies of group 13 for patentability.

3. Inventions of groups 1-13 and group 14 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions of groups 1-13 have separate utility such as a die not requiring a back side configured to be supported by a portable press and having a thickness maintain its planarity when not supported and a cutting edge protruding from the plate wherein pressure is applied to a back side of the plate set forth in group 14, and conversely, invention of group 14 has separate utility such as a die not requiring cutting edge protruding from the plate about 0.015 inch to about 0.02 inch of groups 1-2, 4, 6, 8, 10, and 12, the ejection element of group 3, a thickness of the plate being less than the height of the cutting edge of group 5, the plate comprising one of a magnetic material and a magnetically attractable material of group 7, the plate having a thickness of about 0.01 inch of group 9, and at least one peripheral dimension of the plate is at most about 2 inches or rectangular in shape at most about 2 inches by about 2 inches of group 11. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and

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because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Friday 9:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC
28 November 2004


STEPHEN CHOI
PRIMARY EXAMINER